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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,796	10/26/2001	Harald Krodel	10537/172	6056

26646	7590	05/04/2006

KENYON & KENYON LLP
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EXAMINER
BADII, BEHRANG

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 February 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-13</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-13</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Response to Arguments

Applicant's arguments with respect to claim 1-13 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments, the recitation "accompanies goods to be shipped" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

It is inherent that when an error code is generated, this error code is generated due to an error and corresponds to an error. It is also inherent that a document is sent with merchandise.

2112 [R-3] Requirements of Rejection Based on Inherency; Burden of Proof

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Mahar,

USP 5,418,965, and further in view of Morris, USP 5,386,533 and Ludwig, USPAP

2002/0046352.

As per claims 1 and 5, Mahar discloses a method/information system for verifying

electronic data records including at least one of electronic shipping-voucher data and

shipping data sent by a sender to an information system, comprising the steps of:

receiving the electronic data record by the information system (The system

receives data) (col.5, 50-62), checking the data record by the information system for a

presence of errors (The system checks for errors. col.13, 43-68; col.14, 1-36) and

routing the data record to a receiver if the data record is error-free (The system routes

and stores data from one database onto another. col. 15. 54-65; fig's. 4 & 5). Mahar

does not disclose checking for conformity with a purchase order or the at least one of

the electronic shipping-voucher data and the shipping data accompanying goods to be

shipped or verifying the sender is authorized to send or storing the data record in a

defined access area of the information system if the data record is faulty, the data

record stored in the defined access area being inspectable and correctable by the

sender or determining whether a syntax of the data record conforms with a specified

standard. Morris discloses determining whether a syntax of the data record conforms with a specified standard (checking for mistakes) (claims 15, 27, 40, 51 and 67) and storing the data record in a defined access area of the information system if the data record is faulty, the data record stored in the defined access area being inspectable and correctable by the sender (storing faulty data and then correcting them) (claims 15, 27, 40, 51 and 67). Ludwig discloses checking for conformity with a purchase order (changing shipping documents) (p4) and the at least one of the electronic shipping-voucher data and the shipping data accompanying goods to be shipped (p4) and verifying the sender is authorized to send (p14, 17 and 20). It would have been obvious to modify Mahar to include checking for conformity with a purchase order and the at least one of the electronic shipping-voucher data and the shipping data accompanying goods to be shipped and verifying the sender is authorized to send and storing the data record in a defined access area of the information system if the data record is faulty, the data record stored in the defined access area being inspectable and correctable by the sender and determining whether a syntax of the data record conforms with a specified standard such as that taught by Morris and Ludwig in order to correct the data before it is passed on to other sections of the network thereby reducing the time and effort needed for data correction.

As per claims 2, Mahar further discloses adjusting information of the data record in accordance with ordering information stored in a database (col.15, 44-53).

As per claims 3, Mahar discloses wherein the checking step is performed for a plurality of at least one of plants and areas of plant operations of a system provider

jointly at a single central location (There is a central processing CPU that undertakes

various activities, including storing data on various databases. col.1, 38-65).

As per claims 4, Mahar discloses a method/information system for verifying

electronic data records as discussed above. Mahar further discloses displaying

information in the defined access area in accordance with the analyzing step (col.13,

43-68; col.14, 1-36). Mahar does not disclose analyzing a number and a type of errors

of faulty data records contained in the defined access area with respect to development

over time. Morris discloses analyzing a number and a type of errors of faulty data

records contained in the defined access area with respect to development over time

(claims 15, 27, 40, 51 and 67). It would have been obvious to modify Mahar to include

analyzing a number and a type of errors of faulty data records contained in the defined

access area such as that taught by Morris in order to correct the data before it is passed

on to other sections of the network thereby reducing the time and effort needed for data

correction.

As per claims 6, Mahar discloses an interface to a database containing order

information (col.2, 42-61).

As per claims 7, Mahar discloses wherein the data records contained in the

defined access area are inspectable and revisable (col.2, 1-25; fig.6) by the sender

(user) via the Internet (network) (col.7, 1-52).

As per claims 8, Mahar discloses wherein the faulty data records stored in the

defined access area are inspectable by the receiver (user) (col.2, 1-25; fig.6).

As per claims 9, Mahar discloses wherein the data records contained in the defined access area are inspectable and revisable (col.2, 1-25; fig.6) by the sender (user) via a data network (col.7, 1-52).

As per claim 10, Mahar discloses a method/information system for verifying electronic data records as discussed above. Mahar does not disclose comprising the step of correcting the faulty data record stored in the defined access area of the information system. Morris discloses comprising the step of correcting the faulty data record stored in the defined access area of the information system (claims 15, 27, 40, 51 and 67). It would have been obvious to modify Mahar to include comprising the step of correcting the faulty data record stored in the defined access area of the information system such as that taught by Morris in order to correct the data before it is passed on to other sections of the network thereby reducing the time and effort needed for data correction.

As per claims 11 and 13, Mahar discloses wherein error codes are associated with errors (col. 13, 33-68; col.14, 1-36). Mahar does not disclose the storage of faulty records. Morris discloses the storage of faulty records (claims 15, 27, 40, 51 and 67). It would have been obvious to modify Mahar to include the storage of faulty records such as that taught by Morris in order to correct the data before it is passed on to other sections of the network thereby reducing the time and effort needed for data correction.

As per claim 12, Mahar discloses further comprising a fourth interface to correct the faulty data record (correcting/changing data) (col. 13, 33-68; col.14, 1-36) (col.2, 26-61).

Conclusion

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Behrang Badii whose telephone number is 571-272-
6879. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, James Trammell can be reached on 571-272-6712. The fax phone number
for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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> Commissioner for Patents
> P.O. Box 1450
> Alexandria, VA 22313-1450

or faxed to (571)273-8300

Hand delivered responses should be brought to

> United States Patent and Trademark Office
> Customer Service Window
> Randolph Building
> 401 Dulany Street

Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application
or proceeding should be directed to the Technology Center 3600 Customer Service
Office whose telephone number is **(571) 272-3600**.

Behrang Badii
Patent Examiner
Art Unit 3621

BB

PRIMARY EXAMINER